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In re Application of	:	
BOURDON, Mario A., et al.	:	
Application No.: 09/701,162	:	DECISION ON
PCT No.: PCT/US98/25791	:	
Int. Filing Date: 04 December 1998	:	PETITION UNDER
Priority Date: 05 December 1997	:	
Attorney Docket No.: LJIEM110-1	:	37 CFR 1.47(a)
For: INHIBITION OF TUMOR GROWTH	:	
BY MACROPHAGE INTERVENTION	:	

This is a decision on applicant's "PETITION UNDER 37 CFR §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 05 September 2001.

BACKGROUND

On 04 December 1998, applicants filed international application PCT/US98/25791, which claimed a priority date of 05 December 1997. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 June 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 June 1999, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 05 June 2000.

On 22 November 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and petition to revive.

On 08 February 2001, USPTO mailed a petition decision granting applicants' petition to revive.

On 05 April 2001, USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for reply.

On 05 September 2001, applicants submitted the instant petition under 37 CFR 1.47, which was accompanied by, *inter alia*, a petition for a three-month extension of time; the fee for a

three-month extension of time; a declaration executed by four of the five inventors; a statement by Mario Bourdon; a certified mail receipt and a copy of letter to Dr. Per Borgström from Mario Bourdon.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Item (1) has been met. The petition fee of \$130 will be charged to deposit account no. 03-3875 as authorized by the "Petition Under 37 CFR 1.47(a)."

Item (2) has not been met. Under 37 CFR 1.47(a), the petition must supply proof of pertinent facts.

The statement included is signed by Mario Bourdon. It states "I had my assistant, Margaret Toma, call Per Borgström ... Per Borgström declined to sign the Declaration..." It seems clear that Mr. Bourdon lacks personal knowledge of these events. MPEP §409.03(d) states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

In this situation, the person present for the refusal would appear to be Ms. Toma. When 37 CFR 1.47 applicants conclude that the nonsigning inventor's conduct constitutes a refusal, "all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition." MPEP §409.03(d).

Further, the record does not indicate that inventor Borgström was presented with a full set of application papers. With regard to the letters sent, the only enclosure mentioned is the Declaration. Applicants have to demonstrate that a *bona fide* attempt was made to present a copy of the application papers to the inventors. MPEP §409.03(d).

Item (3) has not been met. The last known address should be the last address at which the inventor customarily received mail. MPEP §409.03(e) and §605.03. "Ordinarily, the last known address will be the last known residence of the nonsigning inventor." MPEP §409.03(e). Further,

MPEP §605.03 requires that the inventor's most recent home address be given to enable the Office to communicate directly with the inventor as necessary. "Sidney Kimmel Cancer Center" is not a home address. Additionally, "other addresses at which the nonsigning inventor may be reached should also be given." MPEP §409.03(e).

Item (4) has not been met. The declaration is not complete. The Office has been supplied one page 1, one page 4, and two pages numbered 3. Page 2 has been entirely omitted. While it is acceptable for an inventor to sign on a different copy of the declaration than the other inventors, the full copy of the declaration must be supplied listing all of the inventors.

CONCLUSION

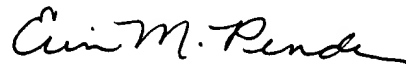
For the above reasons, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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